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5073	7590	09/06/2011		EXAMINER
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980				PATTERSON, MARIE D
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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2001 ROSS AVENUE
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In re Application of: :
FRYE, NANCY C. :
Serial No. 10/790,923 :
Filed: March 1, 2004 : :: DECISION ON PETITION
Docket: 063293.0110
Title: SHOE AND LAST

This is a decision on the renewed petition filed on July 5, 2011 seeking reversal of the drawing objection under 37 CFR 1.83(a). The petition is being considered pursuant to 37 CFR 1.181. No fee is required.

The petition is **DENIED**.

In the earlier petition, the petitioner requests a review of the examiner's objection to the drawings under 37 CFR § 1.83(a)¹. The examiner objected to the drawing on the grounds that the claimed subject matter of claims 8, 9, 16 and 20 were not illustrated. In particular, the examiner required the applicant to illustrate the claimed "midsole(s)". Petitioner believes that the Replacement drawing to Fig. 14 is supported by the originally filed specification and overcome the Rule 83 drawing objection. The examiner disagrees because the Replacement drawing of Fig. 14 contains new matter not supported by the originally filed specification. In the current renewed petition, petitioner alleges that in the decision of March 1, 2010 rendered by the Board of Patent Appeals and Interferences (BPAI), the appellant was informed that the Drawing objection is decided by petition and not an appealable matter. Petitioner believes the applicant is now caught in an endless loop where the issue is passed off by the Board.

¹ § 1.83 Content of drawing. (a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box). In addition, tables and sequence listings that are included in the specification are, except for applications filed under 35 U.S.C. 371, not permitted to be included in the drawings.

Discussion and Analysis

A review of the record indicates that the drawing objection and claim rejection are directed to the same issues. In the non-final Office action of April 21, 2011 rejection of claims 1, 5-9, 11, 14-16 and 19-24 under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. The remainder rejection² has been reproduced below. The examiner cannot find support for these claim limitations. It is not clear how these limitations and structural arrangements were disclosed in the original specification or drawings. On Paragraph 8 of the non-final Office action of April 21, 2011, the examiner further states that page 22 of the specification is confusing and not clear as to how planar surfaces of a midsole would provide the claimed benefits of a negative heel configuration as stated. These passages do not provide clear basis for claiming a midsole or for addition of a midsole to the drawings. There is no language as to how thick the midsole are, the length, the shape, exact location, etc. of a midsole. The examiner believes that the specification as a whole lacks enablement for claiming a midsole. In the non-final Office action of April 21, 2011, the examiner also objected to the drawing that the subject matters of claims are not shown by the original drawings. That is, the correctness of the examiner's drawing objection, resting on the lack of clarity of the claimed the location of point 824 of midsole, is dependent on the correctness of the examiner's 35 USC 112 first paragraph rejection of claims based on the original specification. It is the policy of the USPTO in appropriate circumstances to decline to rule on a petitionable issue, when, as here, that an issue is also determinative of a rejection, and as such, is appropriate for consideration on appeal to the BPAI. In this case, the issue in the objection and rejection, as here, additionally and necessarily requires the exercise of technical skill and legal judgment in order to evaluate the facts presented, the issue is properly decided on the merits, and is properly reviewed on appeal, not petition. Under the circumstances, it is believed that the issues presented under the claim rejections and drawing objection in the instant case require the same review by the BPAI. Thus, this issue is appealable and should not be decided by petition.

Petitioner also argues that the drawing objection was decided by the Board in the decision rendered on March 1, 2010. This is incorrect because the rejection of the present claims under the first paragraph of the 35 USC 112 was not present in the Examiner's Answer of October 8, 2008. However, on page 16 of the decision the Board did acknowledge that the drawing objection under 37 CFR 1.83 issue was unrelated to the claim rejection under appeal. Therefore, the Board could not have decided on the issue of the drawing objection.

² The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification and drawings are confusing and inconsistent and therefore do not provide adequate basis to enable one of ordinary skill in the art to make the claimed shoe because it is not clear where the location of point 824 is to be located. The specification states "approximately 1/2 the length" however the drawings clearly show such a location to be in the forefoot of the footwear. One of ordinary skill in the art would not be able to determine which location is appropriate for the invention. Also the drawings do not show a midsole and one of ordinary skill in the art would not know what thickness, shape, exact location etc. would be appropriate. Therefore the specification lacks enablement for a midsole or the location of the point which the forward toe section of constant thickness of the insole meets the heel section of the insole with a decreasing thickness.

With regard to the request for issuance of a Notice of Allowance, a TC Director can not compel an examiner to ignore the patent statutes of 35 USC 112 and direct the examiner to allow an application. If petitioner believes that the examiner has erred in his judgment in the non-final Office action of April 21, 2011, a proper course of action would be to file an appeal brief to have the examiner's rejection reversed. The applicant always has the right to appeal the examiner's patentability determination to the Board if the applicant still disagrees with the stated position of the examiner. Therefore, the requested relief for issuance of a Notice of Allowance can not be granted.

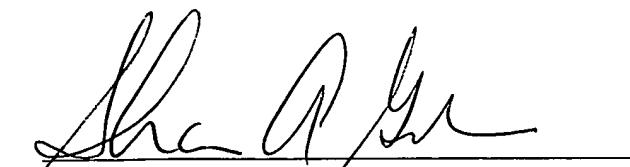
Conclusion

The renewed petition fails to add anything new that is persuasive to cause reversal of the previous decision. The previous decision is maintained. For the foregoing reasons, the relief requested by the petitioner will not be granted. Because there are both an objection to drawings under 37 CFR 1.83(a) and a rejection to claims under 35 USC 112, first paragraph, and both the correctness of the objection and the rejection depend on the same issue, the issue is an appealable one and will not be decided by petition. Petitioner is reminded that the mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings.

The application is being forwarded to the examiner via the Supervisory Patent Examiner of Art Unit 3765 awaiting a response to the outstanding Office action mailed on April 21, 2011. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181" and directed to the Office of the Deputy Commissioner for Patent Examination Policy at Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. See MPEP 1002.02(b).

Any inquiry regarding this decision should be directed to Henry C. Yuen, Supervisory Patent Examiner, at (571) 272-4856.

Accordingly, the petition is denied



Sharon A. Gibson, Director
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